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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,142	11/14/2003	Robert Edward Williams		2384

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EXAMINER

GUTIERREZ, ANTHONY

ART UNIT	PAPER NUMBER
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2857

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/714,142	<b>Applicant(s)</b> WILLIAMS, ROBERT EDWARD	
	<b>Examiner</b> Anthony Gutierrez	<b>Art Unit</b> 2857	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 8-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-14 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Objections*

1. Claim 8 is objected to because of the following informalities: It contains the extraneous phrase, "Fig. 2" at the end of the claim. This phrase should be deleted, but all other reference numerals in the claims need not be deleted.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 13 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 is drawn to "A map **system** as recited in claim 8...". Claim 8 is drawn to a **method** for generating maps and does not recite a map system. Since a system claim is generally considered an apparatus claim and a method claim a process claim, the two should generally be claimed independently. Claim 13 is indefinite because it is unclear to the Examiner what subject matter of claim 8 specifically constitutes a map system, as there exists no clear basis for the phrase "map system" of claim 13 in claim 8.

Claim 14 is drawn to a method of generating maps comprising multiple means. When used in claims the specific words "means" or "step" incorporate the corresponding structure, material, or acts described in the specification (see M.P.E.P. 2181 IV). As the claim is drawn to a method, the Examiner considers the proper word

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to be used to be "step". If the intention is for the claims to cover the "corresponding apparatus structure described in the specification", and if this apparatus structure is fully supported in the specification, the preamble of the claim should be drawn to either a system or apparatus and not a method (or process). It is unclear to the Examiner which statutory category is intended.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 8-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A process is statutory if it requires physical acts to be performed outside the computer independent of and following the steps to be performed by a programmed computer, where those acts involve the manipulation of tangible physical objects and result in the object having a different physical attribute or structure (see MPEP 2106). A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result; i.e., the method recites a step or act of producing something that is concrete, tangible and useful. Referring to the "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" in determining whether the claim is for a "practical application," the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that

**the final result achieved by the claimed invention is "useful, tangible and concrete."**

(<http://www.uspto.gov/web/offices/com/sol/og/2005/week47/patgupa.htm>)

The claimed methods perform processes for generating maps. The map components are described, but a claimed step of actually generating the maps is not present nor are the maps subsequently output or used in any manner. No information is presented to a user nor does a physical transformation occur outside the processing means as a result. The claims do not produce a **result** as no claims specifically include steps of actually generating the maps.

Furthermore, were the claims to specifically recite generating the maps, this **result** would further need to be made **tangible** (as for example, in the form of presenting the maps to a user by a step of displaying the maps). The maps may also lack concreteness if the basis on which they are formed is insufficient to assure their reproducibility.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 8-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Hattori et al. (United States Patent 5,546,327).

As to claims 8-11, 13, and 14, Hattori et al. discloses a method for generating multi-dimensional and multi- hierarchical maps, providing information on spatial and energy relationships between space and events with structural forms, sizes, shapes, locations, geometries and topologies of platens, domains , and domain boundaries among a plurality of said related events in the universe; said maps being generated by an iterative process (see Fig.2 ), such that location and characteristics of each said platen between pairs of said events, and location and characteristics among said domain and said domain boundaries among groups of said events, are determined and generated by a plurality of selected appropriate mathematical rules and conceptual conventions(col. 3, lines 32-50) and each said event and its surrounding said domain is shown enclosed by a system of said platens forming said domain boundary wherein each said domain boundary is determined by said plurality of selected appropriate mathematical rules and conceptual conventions, and shown to approximate the shape of a modifiable sphere; each said platen between said interrelated said events is determined by said plurality of selected appropriate mathematical rules and conceptual conventions (col. 3, lines 51-65) , and shown to characteristically have a diameter less than the approximate diameter of the smaller of said event pairs (col. 9, lines 49-64), a plurality of said platens of a plurality of said events are determined by said plurality of selected appropriate mathematical rules and conceptual conventions to show said structural forms, sizes, shapes. locations geometries and topologies of said events, domains, domain boundaries, and spatial-energy relationships as continuously linked said platens (col. 4, lines 25-39); interlinked said platens are determined by said plurality of selected appropriate mathematical

entities and conceptual conventions, and shown as continuous interconnected pathways among said events and domain boundaries depicted in said map, whereby said spatial and energy relationships among said events and space are depicted, and whereby said structural geometric, and topological relationships among said events, domains, domain boundaries, platens, and space are presented (col. 4, line 40-col. 5, line 26).

As to claim 12, Hattori et al. discloses that said iterative process requires a decision to place each added said event on one of said multi-hierarchical and multi-dimensional levels, said iterative process requires that, as each said event and its accompanying said domain is added to the said map, a decision is made regarding whether or not there exists a grouping of other said events within or without the added said event, and said iterative process requires that said decision is within the context of the added said event (col. 7, lines 32-44).

### ***Response to Amendment***

8. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

In the response filed 4/5/06, Applicant argued that the Examiner failed to act in accordance with M.P.E.P. 707.07 (j) regarding the rule "...in all cases where it is apparent that the applicant is unfamiliar with the proper preparation and prosecution of patent applications".

The Examiner maintains that he has acted in accordance with the rule, as will be addressed below, but has withdrawn the finality of the previous office action as the Examiner considers Applicant's Conditional Request for Constructive Assistance in the Action dated 10/14/05 to be a point, raised by the Applicant and unaddressed by the Examiner, before making the rejection final. The Examiner therefore failed to provide a proper basis on which Applicant could further respond before Final Rejection of the claims.

The Examiner maintains that prosecution has been in accordance with the rule for two reasons. This is the response to the request that the Examiner should have provided before Final Rejection of the claims.

Although the Examiner is aware that the Applicant is an Applicant *pro se*, the Examiner does not necessarily consider it to be "apparent that the applicant is unfamiliar with the proper preparation and prosecution of patent applications". The Examiner feels that he, in a series of phone call discussions with the Applicant, has provided the Applicant *pro se* with instructions regarding the nature of rejections under 35 U.S.C. 112, 101, 102, and 103, as well as the criteria for finality of rejections and after final responses.

Notwithstanding this issue, the rule specifically states "When, during the examination of a *pro se* application it becomes apparent to the examiner that there is patentable subject matter disclosed in the application...". During the examination, it has **not** become apparent to the examiner that there is patentable subject matter disclosed. This does not mean that the Examiner has made a determination that there is no patentable subject matter in the application, but rather that the Examiner has not



discovered patentable subject matter during examination, and then chosen to remain silent on the issue. The Examiner maintains that his action is completely consistent with M.P.E.P. 707.07 (j).

As a service to the Applicant Examiner is here providing information where patentable subject matter may potentially exist. The Examiner has presently provided rejections under 35 U.S.C. 101, regarding statutory criteria for patent eligible subject matter. All definite claims are drawn to a process. The process is for mapping. The subject matter which is mapped is apparently theoretical by applicant's disclosure of theoretical modalities as well as the theoretical nature of the Annotated Glossary, originally described with respect to the invention itself, now forming part of the background of the invention by amendment suggested by the Examiner. The Examiner maintains that patent eligible subject matter may exist in the form of mapping of theoretical information so long as the process provides a useful, concrete, and tangible result. The Examiner considers the claims to presently lack a tangible result as addressed above in the rejection under 35 U.S.C. 101. Possible patentable subject matter with respect to prior art (in other words, avoiding rejections under 35 U.S.C. 102 or 103), may also lack concreteness (in other words, still be rejected under 35 USC 101, even if a tangible result is provided). The Applicant refers to five general characteristics (page 51) that tend to remain constant amidst the randomness of related mapping events. The randomness of the events themselves (which forms the basis of the mapping), in part, prevents the Examiner from presently concluding that patent eligible subject matter is necessarily present in the application. The five general characteristics

might provide eligible subject matter if the determination can be made that they provide sufficient assurance of their reproducibility in the process of mapping (concreteness). It would remain unclear to the Examiner, however, if the five characteristics are part of Applicant's invention or is well known to those of ordinary skill in the art of, for example, soap bubbles or crystals where mapping is known to be performed relying on such geometrical or topological constraints. The same applies for the concentric shell clustering equations of page 54. Lastly, the theoretical modalities of table 1:20 seem to clearly rely on components well known in different art areas. Claims that incorporate the relationship of a general form into the specific form of mapping may possibly provide a general novel distinctions, but the Examiner considers the possibility that the general form of any and or all of the specifics components may possibly be inherent or anticipated by any number of references regarding mapping in each individual art area for each individual component.

The Examiner maintains his grounds of rejection with respect to prior art (under 35 U.S.C. 102) with respect to the pending claims and presently includes new rejections with respect to that statutory requirements for claimed subject matter to be patent eligible (under 35 U.S.C. 101).

The Examiner recommends that any attempt to amend the claims insure that that the process provides a useful, concrete, and tangible result, in other words that the process claim recite a step where the map is specifically generated based on useful, concrete method steps or formulations and that the resulting map is made tangible by being made available to a user through a claimed step of displaying the map and incorporate subject matter that includes Applicant's designated equations, formulas, or

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modalities, in a way that would not have been obvious to one of ordinary skill in the art at the time of invention, wherein **the art is understood to be broadly** the art of mapping spatial and energy related information that is based on a general understanding of the broadest reasonable understanding of the terms: events, domains, and domain boundaries.

### **Conclusion**

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Gutierrez whose telephone number is (571) 272-2215. The examiner can normally be reached on Monday to Friday.

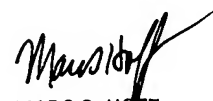
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc Hoff can be reached on (571) 272-2216. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AG

Anthony Gutierrez

8/31/06



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